UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,287	08/01/2003	Kenji Yamane	112857-418	3340

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EXAMINER
BANTAMOI, ANTHONY

ART UNIT	PAPER NUMBER
2609	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/633,287	YAMANE, KENJI
	Examiner	Art Unit	
	Anthony Bantamoi	2609	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>01 August 2003</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-13</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-13</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

    1.☐ Certified copies of the priority documents have been received.

    2.☐ Certified copies of the priority documents have been received in Application No. _____.

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 6 and 13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claims 6 and 13 define a computer program embodying functional descriptive material. However, the claim does not define a computer-readable medium or computer-readable memory and is thus non-statutory for that reason. The examiner suggests amending claims 6 and 13 to include a computer-readable medium or its equivalent assuming the specification does not define the computer-readable medium as a signal or a carrier wave or a transmission medium, which are deemed non-statutory. Any amendment to the claim should be commensurate with its corresponding disclosure.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 3-4 rejected under 35 U.S.C. 102(e) as being anticipated by over Shimizu et al

(U.S. Patent Application 2002/0162111), hereinafter referenced as Shimizu.

Regarding claim 3, Shimizu teaches a data communication system, transmitting

device, and communication terminal, which reads on "An information processing

apparatus comprising: receiving means for receiving a content from another information

processing apparatus; detection means for detecting a tile being displayed in the

content; holding means for holding information of the tile detected by the detection

means; and transmission means for transmitting the information of the tile held by the

holding means to the another information processing apparatus", in addition Shimizu

discloses a receiving unit to receive information from the transmission devise, which

reads on "receiving means for receiving a content from another information processing

apparatus" (claim 2, lines 5-6), in addition Shimizu discloses a reading unit for reading

out image data stored in first and second storage, which reads on "detection means for

detecting a tile being displayed in the content" (claim 2, lines 11-12), in addition

Shimizu discloses a first and second storage for storing first and second data

respectively, which reads on "holding means for holding information of the tile detected

by the detection means" (claim 2, lines 7-10), in addition Shimizu disclose a transmitting

device to transmit data to the receiving device, which reads on "and transmission

means for transmitting the information of the tile held by the holding means to the

another information processing apparatus" (claim 2. lines 3-6).

Regarding claim 4, Shimizu demonstrated all the elements as applied to

claim 3, and further discloses the system that performs the steps as in claim 4,

therefore, claim 4 is similarly rejected as claim 3.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 5, and 7-12, are rejected under 35 U.S.C. 103(a) as being unpatentable

over Shimizu et al (U.S. Patent Application 2002/0162111) in view of Fujiwara (U.S.

Patent 6,992,788), hereinafter referenced as Shimizu and Fujiwara.

Regarding claim 1, Shimizu teaches a data communication system, transmitting

device, and communication terminal, which reads on "An information processing system

comprising:

a first information processing apparatus for receiving a first content; and a second

information processing apparatus for transmitting the first content to the first information

processing apparatus; the first information processing apparatus comprising, receiving

means for receiving the first content from the second information processing apparatus,

and the second information processing apparatus comprising, first acquisition means for

acquiring the first content, second acquisition means for acquiring a second content,

synthesis means for combining the second content with the first content in units of tiles,

and second transmission means for transmitting a resultant content obtained by

combining the second content with the first content by the synthesis means, to the first

information processing apparatus", in addition Shimizu discloses a data receiving unit

for receiving the first data transmitted from the transmitting device, which reads on "a

first information processing apparatus for receiving a first content" (claim 1, lines 16-17),

in addition Shimizu teaches a transmitting unit for transmitting the first data to the

receiving unit, which reads on "a second information processing apparatus for

transmitting the first content to the first information processing apparatus" (claim 1, lines

11-12), in addition Shimizu discloses a communication terminal (figure 10, item 2) which

consists of a data receiving means(21) to receive the first data from the transmitting unit

(figure 10, item 11), which reads on "receiving means for receiving the first content from

the second information processing apparatus" (figure 10), in addition Shimizu discloses

a selection means to select the first data content in response to request for

transmission, which reads on "first acquisition means for acquiring the first content"

(claim 1, lines 8-10), in addition Shimizu discloses a control unit (12) that extracts data

from memory content, which reads on ", second acquisition means for acquiring a

second content" (page 2, section 0028), however, Shimizu failed to disclose a synthesis

means for combining the first content with the second content in units of tiles but

Fujiwara teaches a combiner means for combining compressed scaled picture data

from several nodes of a video transmission, which reads on "synthesis means for

combining the second content with the first content in units of tiles" (column 8, lines 37-

39) and is exhibited in figure 3. Therefore, the examiner maintains that it would have

been obvious for one with ordinary skill in the art at the time the invention was made to

modify Shimizu by specifically providing a synthesis means as taught by Fujiwara for the purpose of reducing transmission delays as well as conserving bandwidth. Furthermore, Shimizu discloses a transmitting means that transmits the first and second data to the receiver device, which reads on "and second transmission means for transmitting a resultant content obtained by combining the second content with the first content by the synthesis means, to the first information processing apparatus" (claim 1, lines 11-12).

Regarding claim 2, Shimizu and Fujiwara demonstrated all the elements as applied to claim 1, and further discloses the system that performs the methods as in claim 2, therefore, claim 2 is similarly rejected as claim 1.

Regarding claim 5, Shimizu demonstrated all the elements as applied to claim 3 the examiner therefore maintains that computer program in claim 5 is an obvious variation of the method of claim 3 because it was well known in the art by the time the invention was made to write computer programs to control machines. Hence claim 5 is rejected for the same reasons as claim 3.

Regarding clam 7, Shimizu teaches a data communication system, transmitting device, and communication terminal, which reads "An information processing apparatus comprising: first acquisition means for acquiring a first content; second acquisition means for acquiring a second content; synthesis means for combining the second content with the first content in units of tiles; and transmission means for transmitting a resultant content obtained by combining the second content with the first content in units of tiles by the synthesis means, to another information processing apparatus", in

addition Shimizu discloses a selection to means to select the first data content in response to request for transmission, which reads on "first acquisition means for acquiring the first content" (claim 1, lines 8-10), in addition Shimizu discloses a control unit (12) that extracts data from memory content, which reads on ", second acquisition means for acquiring a second content" (page 2, section 0028), however, Shimizu failed to disclose a synthesis means for combining the first content with the second content in units of tiles but Fujiwara teaches a combiner means for combining compressed scaled picture data from several nodes of a video transmission, which reads on "synthesis means for combining the second content with the first content in units of tiles" (column 8, lines 37-39) and is exhibited in figure 3. Therefore, the examiner maintains that it would have been obvious for one with ordinary skill in the art at the time the invention was made to modify Shimizu by specifically providing a synthesis means as taught by Fujiwara for the purpose of shortening transmission delays. Furthermore, Shimizu discloses a transmitting means that transmits the first and second data to the receiver device, which reads on "and second transmission means for transmitting a resultant content obtained by combining the second content with the first content by the synthesis means, to the first information processing apparatus" (claim 1, lines 11-12).

Regarding claim 8, Shimizu and Fujiwara discloses everything as above (see claim 7). In addition Shimizu discloses a display indicating that the second data is being displayed, which reads on "receiving means for receiving information of a tile being displayed by the another information processing apparatus, from the another information processing apparatus" (claim 21, lines 3-4), in addition Shimizu discloses a

selection means for selecting whether the second data can be read or not, which reads on "selection means for selecting the second content to be combined with the first content, according to the information of the tile, received by the receiving means" (claim 11), however, Shimizu failed to disclose a synthesis means for combining the first content with the second content but Fujiwara teaches a combiner means for combining compressed scaled picture data from several nodes of a video transmission, which reads on "wherein the synthesis means combines the second content selected by the selection means with the first content" (column 8, lines 37-39) and is exhibited in figure 3. Therefore, the examiner maintains that it would have been obvious for one with ordinary skill in the art at the time the invention was made to modify Shimizu by specifically providing a synthesis means as taught by Fujiwara for the purpose of shortening transmission delays.

Regarding claim 9, Shimizu and Fujiwara discloses everything as above (see claim 8). In addition Shimizu discloses a data storage for storing first and second data, which reads on "further comprising holding means for holding information of a specific tile specified in advance among tiles" (claim 2, lines 7-10), however, Shimizu failed to disclose a synthesis means for combining the first content with the second content but Fujiwara teaches a combiner means for combining compressed scaled picture data from several nodes of a video transmission, which reads on "where in the synthesis means replaces a part of the first content, corresponding to the specific tile with the second content" (column 8, lines 37-39) and is exhibited in figure 3. Therefore, the examiner maintains that it would have been obvious for one with ordinary skill in the art

at the time the invention was made to modify Shimizu by specifically providing a synthesis means as taught by Fujiwara for the purpose of shortening transmission delays.

Regarding claim 10, Shimizu and Fujiwara discloses everything as above (see claim 9). In addition Shimizu discloses a control unit for performing control such that the reading or detection unit reads out data from first or second storage on the level or amount of first data available in first storage, which reads on " further comprising calculating means for calculating the popularity of the specific tile according to the information of the tile" (claim 13, lines 16-19), in addition Shimizu discloses a selection unit for selecting whether the second data content can be read or not, which reads on" wherein the selection means selects the second content according to the popularity" (claim 11, lines 3-4).

Regarding claim 11, Shimizu and Fujiwara demonstrated all the elements as applied to claim 1, and further discloses the system that performs the method as in claim 11, therefore, claim 11 is similarly rejected as claim 1.
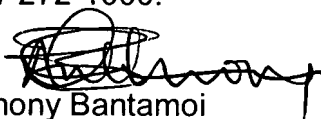
Regarding claim 12, Shimizu and Fujiwara demonstrated all the elements as applied to claim 7 the examiner therefore maintains that computer program on storage medium (software) in claim 12 is an obvious variation of the method performed by the apparatus of claim 7 because it was well known in the art by the time the invention was made to write computer programs to control machine processes. Hence claim 12 is rejected for the same reasons as claim 7.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Bantamoi whose telephone number is 571 270 3581. The examiner can normally be reached on MON.-FRI. 7:30-5:00 EST..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jefferey Harold can be reached on 571 272 7519. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Anthony Bantamoi
Examiner
Art Unit 2609

AB

RYAN YANG   9/24/07
PRIMARY EXAMINER